

REMARKS

The Office action mailed on 25 February 2004 (Paper No. 49) has been carefully considered. Allowance of claims 3 thru 6 as noted in paragraph 14 of the Office action is appreciated.

Claim 10 is being canceled without prejudice or disclaimer, claims 3, 6 thru 9 and 11 are being amended, and new claim 12 is being added. Thus, claims 3 thru 9, 11 and 12 are pending in the application.

In paragraph 4 of the Office action, the Examiner rejected claims 9 thru 11 under 35 U.S.C. §112 (second paragraph) for alleged indefiniteness. Specifically, the Examiner stated that claim 9 was vague and indefinite “because it is not clear (and Applicant's specification does not otherwise provide antecedent basis for ...), what constitutes a ‘most readily accessible region’” (quoting from paragraph 4, lines 4-6 of the Office action). Accordingly, claim 9 is being amended to delete the words “most readily accessible region”. Therefore, the rejection under 35 U.S.C. §112 (second paragraph) no longer applies, and should be withdrawn.

In paragraph 6 of the Office action, the Examiner rejected claims 7 and 8 under 35 U.S.C. §102 for alleged anticipation by Jones, U.S. Patent No. 5,572,660. In paragraph 10 of the Office action, the Examiner rejected claims 9 thru 11 under 35 U.S.C. §103 for alleged unpatentability over Jones '660 in view of Kakuta, U.S. Patent No. 5,583,876. For the reasons

stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

In rejecting claim 7, the Examiner stated that the “added limitation regarding parity being stored sequentially from the most outer cylinder is irrelevant because it was added to the preamble of a Jepson claim”, and therefore “it is to be treated as the remainder of the preamble previously was, that is, as admitted prior art” (quoting from page 4, lines 1-4 of the Office action). The Examiner then added that, if the Applicant did not intend for the limitation in question to be construed as admitted prior art, the added limitation should be moved to be after the “improvement comprising” wording of the claim (*see* page 4, lines 4-6 of the Office action).

Accordingly, independent claim 7 is being amended in a manner consistent with the Examiner's above-quoted suggestion. That is, claim 7 is being amended to recite, after the “improvement comprising” language of the claim, the recitation that “the parity information needed for data recovery is stored and sequentially arranged from the most outer cylinder on a recording medium in each corresponding one of said plurality of defect-adaptive memory devices”. It should be noted that this wording, now added after the “improvement comprising” wording of the claim, corresponds to the limitation which prompted the Board of Patent Appeals and Interference to reverse the previous rejection of claims 3 and 6.

Therefore, since the recitation now added after the "improvement comprising" wording of the claim is consistent with the suggestion set forth by the Examiner at the top of page 4 of the Office action, and since the wording now added after the "improvement comprising" wording of the claim corresponds to the limitation which prompted the Board of Patent Appeals and Interferences to reverse the rejection of claims 3 and 6, independent claim 7 and associated dependent claim 8 should now be in condition for allowance.

Independent claim 9 is being amended to include the recitation from dependent claim 10, which is being canceled. In rejecting dependent claim 10, the Examiner stated (in paragraph 12 of the Office action) that "the teachings of Kakuta include that the first region comprises a most outer cylinder (see Fig. 10 and col. 12[,] lines 21-28; region D4 is shown at and thus comprises the most outer cylinder)" (quoting from paragraph 12 of the Office action). It is respectfully submitted that the statement contained in paragraph 12 of the Office action does not constitute a proper basis for rejection of previous dependent claim 10 (and now currently amended independent claim 9) under 35 U.S.C. §103.

Specifically, whereas it may be true that Kakuta '876 discloses a region D4 in Figure 10 which constitutes the "most outer cylinder", as alleged by the Examiner, there is no disclosure or suggestion in Kakuta '876 or in the primary reference, Jones '660, of a most outer cylinder in which parity information is sequentially stored in a sequential arrangement therein. That is to say, amended claim 9 does not merely recite that a first region comprises a most outer cylinder

of a recording medium, but rather the amended claim further recites that it is in the first region (that is, the most outer cylinder of the recording medium) in which the parity information is sequentially stored in sequential arrangement therein (*see* claim 9, lines 5-6). For this reason, the invention recited in independent claim 9 and associated dependent claim 11 is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

Newly added independent claim 12 is a combination of the recitations of previous independent claim 9 and associated dependent claim 11. In rejecting previous dependent claim 11, the Examiner stated (in paragraph 13 of the Office action) that “Jones selectively obtains parity from the drives, and selectively stores parity obtained in a corresponding cache (Fig. 3E)” (quoting from paragraph 13 of the Office action). It is noted that, in support of the statement, the Examiner merely cites Figure 3E of Jones '660. However, it is not seen where, in Figure 3E, Jones '660 discloses that which was claimed in previous dependent claim 11, and which is now recited in newly added independent claim 12. For that reason, it is submitted that the invention recited in independent claim 12 is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

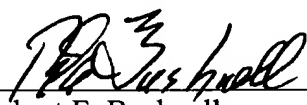
Finally, it should be noted that independent claims 3 and 6, which have been allowed by the Examiner, are being amended merely for the purpose of improving their form. Therefore, the amendment of independent claims 3 and 6 should not adversely affect allowability of these

claims.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$86.00 is incurred by the addition of one (1) independent claim in excess of total 4. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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Folio: P54508
Date: 4/23/04
I.D.: REB/JGS